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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,190	07/19/2001	Jan Kransmo	27943-00418	9134

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ERICSSON INC.  
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PLANO, TX 75024

EXAMINER

SCHULTZ, WILLIAM C

ART UNIT	PAPER NUMBER
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2664

DATE MAILED: 04/21/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/909,190

Applicant(s)

KRANS MO ET AL.

Examiner

William C. Schultz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 12, 14, 15, 18, 21, 25, 26, 29, 31, 35, 37 and 39 is/are rejected.
- 7) ☒ Claim(s) 3-9, 11, 13, 16, 17, 19, 20, 22, 24, 27, 28, 30, 32-34, 36 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2,3.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statement (IDS) submitted on 1/22/2002 and 3/6/2003 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,10,12,15,18,21,31,37,39 are rejected under 35 U.S.C. 102(b) as being anticipated by Laiho [U.S. Pat. 6,061,572].

Regarding claim 1, Laiho discloses a telecommunications system for delivering a Short Message Service (SMS) message within a network capable of providing both voice services on a voice carrier and data services on a data only carrier, said telecommunications system comprising:

a mobile station (MS) supporting both voice services and data services, said MS being currently involved in a data session on said data only carrier; and (**col. 1, line 56; col. 1, line 63; col. 3, lines 39-40**)

a node in wireless communication with said MS for receiving said SMS message, encapsulating said SMS message into an Internet Protocol (IP) packet and routing said

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SMS message to said MS as an electronic mail message over said data only carrier without disrupting said data session. **(col. 3, lines 45-51)**

Regarding claim 15, Laiho discloses a Mobile Services Switching Center for delivering a Short Message Service (SMS) message to a mobile station (MS) supporting both voice services and data services, said Mobile Services Switching Center comprising:

means for determining whether said MS is currently involved in a data session on a data only carrier; and **(col. 1, line 56; col. 1, line 63; col. 3, lines 39-40; col. 3, line 43 – cause code)**

conversion logic for encapsulating said SMS message into an Internet Protocol (IP) packet and routing said SMS message to said MS over said data only carrier as an electronic mail message when said MS is involved in said data session. **(col. 3, lines 45-51)**

Regarding claim 31, Laiho discloses a method for delivering a Short Message Service (SMS) message within a network capable of providing both voice services on a voice carrier and data services on a data only carrier, said method comprising:

receiving at a node in wireless communication with a mobile station (MS) supporting both voice services and data services said SMS message; **(col. 1, line 56; col. 1, line 63; col. 3, lines 39-40)**

determining whether said MS is currently involved in a data session on said data only carrier; **(col. 3, line 43 – cause code)**

if not, routing said SMS message to said MS via said voice carrier; and  
**(col. 3, lines 38-40)**

if so: encapsulating said SMS message into an Internet Protocol (IP)  
packet, and routing said SMS message to said MS as an electronic mail  
message without disrupting said data session.**(col. 3, lines 40-41, lines 46-51)**

Regarding claim 2, Laiho further discloses said node further operates to check  
whether said MS is involved in said data session prior to encapsulating said SMS  
message into said IP packet, said node transmitting said SMS message to said MS  
when said MS is not involved in said-data session. **(col. 3, lines 37-38)**

Regarding claim 10, Laiho further discloses a Short Message Service Center for  
routing said SMS message to said node. **(col. 3, line 46)**

Regarding claims 12,21,39, Laiho further discloses said electronic mail message  
is routed to said MS using an electronic mail address for said MS. **(col. 3, line 62 – col.  
4, line 2)**

Regarding claims 18,37, Laiho further discloses means for receiving said SMS  
message from a Short Message Service Center. (col. 4, lines 7-10)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laiho [U.S. Pat. 6,061,572] as applied to claim 1 above, and further in view of Sexton et al. [U.S. Pat. 6,614,772].

Regarding claim 14, Laiho discloses as above but fails to disclose the wireless network is a CDMA2000 network.

Sexton et al. discloses an SMS delivery system in a CDMA2000 network.**(col. 2, lines 1-8)**

It would have been obvious for one skilled in the art at the time of invention to have the network be CDMA2000. The motivation is so that the invention would be compatible with existing networks and allow easy adoption.

Claims 23,25,26,29,35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laiho [U.S. Pat. 6,061,572] as applied to claim 31 above, and further in view of Huotari [U.S. Pat. 5,987,323].

Regarding claim 23, Laiho discloses a system for delivering a Short Message Service (SMS) message to a mobile station (MS) supporting both voice services and data services, said system comprising:

means for determining whether said MS is currently involved in a data session on a data only carrier; and **(col. 1, line 56; col. 1, line 63; col. 3, lines 39-40; col. 3, line 43 – cause code)**

conversion logic for encapsulating said SMS message into an Internet Protocol (I P) packet and routing said SMS message to said MS over said data only carrier as an

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electronic mail message when said MS is involved in said data session. **(col. 3, lines 45-51)**

Laiho fails to disclose that the system is a Base Station Controller.

Huotari discloses in figure 3 a network diagram which closely matches applicant's fig.2. Huotari discloses the transmission of SMS messages to the mobile by way of the BSC. **(col. 7, lines 1-10)**

It would have been obvious for one skilled in the art at the time of invention to include a BSC. The motivation to modify Laiho with Huotari is so that increased network capacity can be achieved. **(col. 5, lines 48-51)**

Regarding claim 25, Laiho further discloses a Packet Control Function**(col. 3, line 56 – dedicated application, an application is a function)** for determining routing information associated with said MS for said data session, said electronic mail message being delivered to said MS using said routing information. **(col. 3, line 62 – col. 4, line 2)**

Regarding claim 26, Laiho further discloses means for receiving said SMS message from a Short Message Service Center. **(col. 4, lines 7-10)**

Regarding claim 29, Laiho further discloses said conversion logic routes said electronic mail message to said MS using an electronic mail address for said MS. **(col. 3, line 65 – col. 4, line 2 : it is a fact that email addresses resolve to IP addresses)**

Regarding claim 35, Laiho further discloses said step of routing further comprises: routing said electronic message from said Base Station Controller to a

Packet Data Service Node in wireless communication with said MS for said data session; and **(col. 4, line 34)**  
delivering said electronic mail message from said Packet Data Service Node to said MS. **(col. 4, lines 36-42)**

Laiho fails to disclose that the node is a Base Station Controller.

Huotari discloses in figure 3 a network diagram which closely matches applicant's fig.2. Huotari discloses the transmission of SMS messages to the mobile by way of the BSC. **(col. 7, lines 1-10)**

It would have been obvious for one skilled in the art at the time of invention to include a BSC. The motivation to modify Laiho with Huotari is so that increased network capacity can be achieved. **(col. 5, lines 48-51)**

#### ***Allowable Subject Matter***

Claim 3-9,11,13,16-17,19-20,22,24,27-28,30,32-34,36,38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wells et al. [U.S. Pat. 6,125,281] – SMS application using SMSC-linked server on the WWW.




Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Schultz whose telephone number is 703-305-2367. The examiner can normally be reached on M-F(7-4)(first bi-week) M-Th(7-4)(second bi-week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 703-305-4366. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William Schultz



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